

REMARKS

1. Status of Claims

Claims 1-11 and 23-34 were pending in the Application. Applicants have amended claim 1 without prejudice or disclaimer. Applicants respectfully request entry of the above amendments and consideration of the enclosed remarks. Applicants submit that no new matter is added. Accordingly, claims 1-11 and 23-34 will remain pending in the application.

2. Rejections under 35 USC § 101

On page 10 of the Office Action, the Examiner added a new ground of rejection of Claims 1-11 under 35 U.S.C. 101 as allegedly failing to claim statutory subject matter.

Applicants respectfully traverse the rejection. However, in order to expedite prosecution, Applicants have amended claim 1 and the rejection is moot. Applicants respectfully submit that amended claim 1 and dependent claims 2-11 are patentable under 35 USC 101.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

3. Rejections under 35 USC § 103(a)

Claims 1, 4-11, 23, and 26-34 are in the case and stand finally rejected under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent Application Publication No. 2005/0177437A1 by Ferrier ("Ferrier '437") in view of U.S. Patent Application Publication No. 2002/0120475A1 by Morimoto ("Morimoto '475").

Applicants respectfully disagree with the rejection.

Independent claim 1 recites:

1. A method for authorizing payment upon delivery of an item to a destination comprising:
registering each one of a plurality of receiving parties with a transaction module;
registering each one of a plurality of sending parties with the transaction module;

generating an shipment tracking identifier for use with a shipping system;
associating the shipment tracking identifier with a particular sending party, a particular receiving party and the item;
storing data relating to the identifier and the particular sending party in the transaction module;
obtaining shipment tracking identifier data at a destination location from the shipping system indicating that the item has arrived at the destination;
correlating the shipment tracking identifier data to the particular sending party and the item; and
then authorizing a debit associated with the item from a selected account associated with the particular receiving party to a selected account of the particular sending party.

(emphasis added).

Independent claim 23 recites:

23. An apparatus for authorizing payment upon delivery of an item to a destination comprising:
means for registering each one of a plurality of receiving parties with a transaction database;
means for registering each one of a plurality of sending parties with the transaction database;
means for generating an shipment tracking identifier for use with a shipping system;
means for associating the shipment tracking identifier with a particular sending party, a particular receiving party and the item;
means for storing data relating to the identifier and the particular sending party in the transaction database;
means for obtaining shipment tracking identifier data at a destination location from the shipping system indicating that the item has arrived at the destination;
means for correlating the shipment tracking identifier data to the particular sending party and the item; and
means for then authorizing a debit associated with the item from a selected account associated with the particular receiving party to a selected account of the particular sending party.

(emphasis added).

In the Final Office Action, the Examiner rejects the amended claims using the previously applied references and in a Response to Argument section on page 2, suggests the shipping tracking identifier is generated by the USPS or shipping carrier. Contrary to the Examiner's assertion, the specification at publication ¶0050 clearly teaches that an open system postage meter such as that operated by the trusted third party generates the described indicator. Applicants also dispute any new implied statement of Official Notice that might have been intended.

Moreover, the Examiner suggests that Ferrier '437 "implies" an identifier has shipment tracking ability. Applicants respectfully disagree. The reference does not teach or suggest generating a shipment tracking identifier in paragraphs 0071 or 0075, but rather only determines which courier was selected – not tracking the item through the courier system. Here, each independent claim recites generating a shipment tracking identifier that none of the cited references teach or suggest with regard to the claimed invention as a whole. Similarly, Ferrier '437 does not teach or fairly suggest associating a shipment tracking identifier with a sending party, receiving party and an item, since it does not create such an identifier.

Furthermore, it appears rather that Ferrier '437 teaches away from a shipment tracking identifier since the identifier taught there is not globally unique in a carrier system and therefore could not be used as a shipment tracking identifier.

As apparently acknowledged by the Examiner on page 4, sixth paragraph of the Final Office Action, and as in the prior COD system, Ferrier '437 in paragraph 0064 describes only having the courier collect payment from the recipient as a condition precedent of delivery if the recipient happens to be home when the item is delivered.

The Examiner incorrectly suggests that prior COD systems such as the USPS COD system render the invention as presently claimed obvious. In those systems, recipient payment was a condition precedent to delivery. The recipient had to be present and the recipient had to pay – both significant deficiencies in the art. Here, Applicants have disclosed as system that has delivery as the condition precedent to payment release. The recipient need not be present and the recipient need not be

the payor. Accordingly, the system disclosed by Applicants includes several advantages over the prior art including but not limited to those described here. Similarly, as the Examiner apparently acknowledges at top of page 3 of the Final Office Action, Ferrier '437 does not teach or suggest anything further than the traditional COD system in paragraph 0064.

With regard to the Examiner's reference to paragraph 0071 of Ferrier '437 at page 14 of the Examiner's Answer (Office Action), Applicants respectfully submit that the cited portion supports Applicants argument. For example, no money is held in escrow when the package is delivered to a location where no one will be present. The item is paid for without the escrow mechanism being utilized.

Moreover, the Morimoto '475 reference is not properly combined since it has nothing to do with payment systems. It is important to note that one of skill in the art would not look to Morimoto '475 to modify Ferrier '437 or any other traditional COD system since it was not necessary to track the item at all. In the COD systems, the recipient had to be home and have payment before the courier would leave the package. Accordingly, there would be no need to track the item. The Examiner is improperly using hindsight to use the teachings of the present invention as a roadmap to suggest a system that tracks a shipping identifier to determine delivery. Here, the prior art did not teach such as system that does not require the recipient to be present or pay – rather the present application did.

Dependent claims 4-11 and 26-34 are patentable over the cited reference for at least the reasons described above with reference to the associated independent claim and any intervening claims.

Moreover, with regard to claims 6-8 and 28-20, Applicants are claiming three different configurations of the described system, respectively operated by receiving party, sending party and third party. Ferrier '437 does not teach or suggest all three such systems and the Examiner's interpretation of the term operated is clearly incorrect as allegedly equivalent to using.

Moreover, the cited references, even if properly combined, do not teach or suggest every limitation of claims 1, 4-11, 23, and 26-34.

Accordingly, Applicant respectfully submits that the rejection is clearly in error.

Claims 2, 3, 24 and 25 are in the case and stand finally rejected under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent Application Publication No. 2005/0177437A1 by Ferrier ("Ferrier '437") in view of U.S. Patent Application Publication No. 2002/0120475A1 by Morimoto ("Morimoto '475") and in further view of U.S. Patent No. 7,080,044 to Cordery, et al. ("Cordery '044").

Applicants respectfully disagree with the rejection and urge its reversal for at least the reasons stated below. Initially, dependent claims 2, 3, 24 and 25 are patentable over the cited references for at least the reasons described above with reference to the associated independent claim and any intervening claims.

Moreover, if the references when combined suggest an inoperative device, the Examiner may not use the references to establish a prima facie rejection. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339 (Fed. Cir. 2001)(if references taken in combination would produce a "seemingly inoperative device," then such references teach away from the combination and cannot serve as predicates for a prima facie case of obviousness).

As described above, the system of Ferrier '437 uses an identifier that is not globally unique for a carrier and thus would not be used with a shipment tracking identifier. As such, the proposed combination is improper as it would apparently not function.

Moreover, the cited references, even if properly combined, do not teach or suggest every limitation of claims 2, 3, 24 and 25.

Accordingly, Applicant respectfully submits that the rejection is clearly in error.

Accordingly, Applicants respectfully submit that claims 1-11 and 23-34 are in condition for allowance.

4. Conclusion Of Remarks

For at least the reasons stated above, it is respectfully submitted that the claims of this application are in condition for allowance and early and favorable action thereon is requested.

If the Examiner believes that additional issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned attorney for Applicant at (203) 924-3180.

5. Authorization

No fee is believed due with this Amendment. However, the Commissioner is hereby authorized to charge any additional fees which may be required for the response or credit any overpayment to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-715.

In the event that an extension of time or additional extension of time is required to make this response timely filed, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely. The Commissioner is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-715.

Respectfully submitted,
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